



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/801,725 | 03/09/2001 | Tim King | 1591.0050001/RES/RDL | 5084 |
| 26111 | 7590 | 11/05/2004 | EXAMINER | |
| STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | DANG, KHANH | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2111 | | |

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/801,725 | KING ET AL. |
| | Examiner Khanh Dang | Art Unit 2111 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 August 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 7 is objected to because of the following informalities: inline 2, after “plurality of”, the word – classes—should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-4, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, and 11 are directed to an apparatus claim. However, the essential structural cooperative relationship between the so-called “means for mapping” and other recited elements in the claims have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

In claim 8, line 4, the phrase, “sending an email using physical address of a recipient” is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient’s physical address with the recipient’s e-mail address.

In claim 10, lines 12-13, the phrase, “the physical address of said buyer is used to send said email” is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient’s physical address with the recipient’s e-mail address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

With regard to claims 1, 5, and 14, Hogan discloses a system for routing e-mails, comprising: a server (160, for example) that includes a database, the database including a mapping from a physical address to an e-mail address (in Hogan, each regular mail has a corresponding email address), wherein the server (160) is connected to a network (110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular mail), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof); and a recipient host (100, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. With regard to claims 2 and 4, it is clear that in Hogan, the recipient can print the email from the server (160)

and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. With regard to claim 3, it is clear that the server (160) provides a graphical user interface (Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox or is delivered via traditional mail. With regard to claim 11, it is clear that the address of a user stored in a database can always be edited. With regard to claim 13, it is clear that each recipient is assigned with an email box. With regard to claim 16, it is clear that emails can be printed and mailed via traditional mail. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

However, Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of Daniels, Jr. et al.

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Daniel Jr. et al.

Hogan discloses a system for routing e-mails, comprising: a server (160, for example) that includes a database, the database including a mapping from a physical address to an e-mail address (in Hogan, each regular mail has a corresponding email address), wherein the server (160) is connected to a network (110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular mail), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof); and a recipient host (100, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. Further, it is clear that in Hogan, the recipient can

print the email from the server (160) and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. Also, it is clear that the server (160) provides a graphical user interface (Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox or is delivered via traditional mail. In addition, it is clear that each recipient is assigned with an email box. It is also clear that emails can be printed and mailed via traditional mail. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

However, Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art.

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide

Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is tagging selected emails as time sensitive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of tagging selected emails as time sensitive, since the Examiner takes Official Notice that tagging an email as time sensitive is old and well-known; and providing the email server of Hogan with an option of tagging selected emails as time sensitive only involves ordinary skill in the art.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is the use of biometric data for accessing to an electronic mailbox. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of using biometric data for accessing to an electronic mailbox, since the Examiner takes Official Notice that biometric data is old and well-known; and providing

the email server of Hogan with an option of using biometric data for accessing to an electronic mailbox involves ordinary skill in the art.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoken.

Zoken discloses a method of storing an email in an electronic mailbox and mapping the email address of a recipient to a physical address of a recipient. However, Zoken does not disclose mapping the physical address of a recipient to the email address of a recipient. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zoken to provide the option of mapping the physical address of a recipient to the email address of a recipient, since such modification is merely a design choice and involves only ordinary skill in the art.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savino et al.

Savino et al. discloses a method for parcel delivery notification, comprising: receiving an electronic order for a parcel (received purchase order information); generating a parcel barcode representing at least a physical address of a buyer (see at least Fig. 5 and description thereof); scanning a parcel barcode (on a shipping label/packing slip); shipping the same parcel to a parcel delivery center; and scanning the same parcel barcode at said parcel delivery center. Savino et al. does not disclose sending an email notification (email address of a buyer is contained in the bar

code in addition to the buyer's physical address (see at least Fig. 5)) to a buyer when order is received and after shipment of order. Savino et al. also does not disclose mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the steps of sending an email to a buyer after an on-line order is received and another email after the shipment of the order, since the Examiner takes Official Notice that sending email notification to a buyer after an on-line purchase is a common practice in e-commerce. One who places an order with Amazon.com or Dell.com, for example, will receive such notification emails. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to provide Savino with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art.

Response to Arguments

Applicants' arguments filed 8/25/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of

police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 112 Rejection:

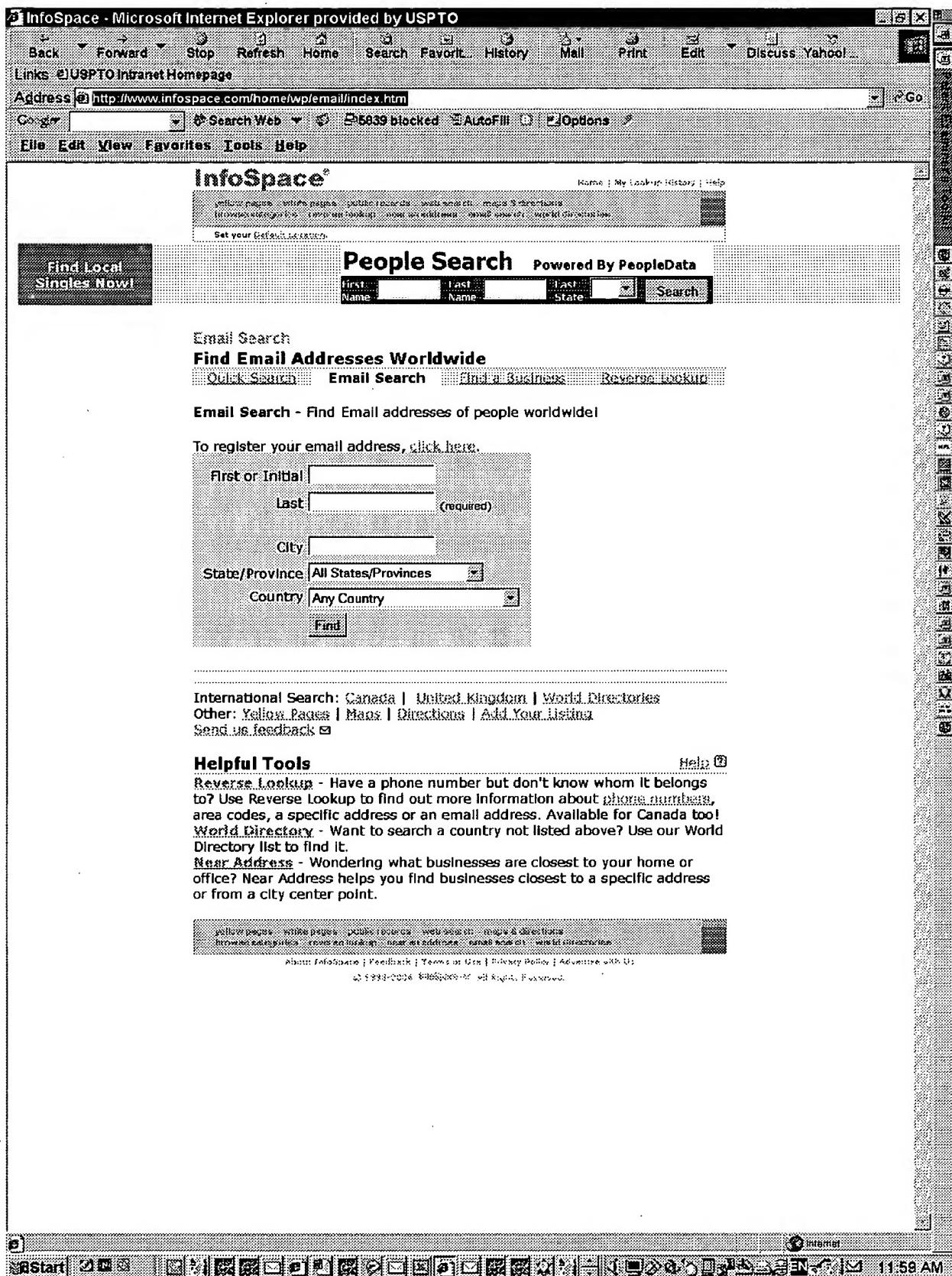
Applicants argue that the "means for mapping is part of the recited server. The recipient host "can access e-mails on said server" per claim 1. Thus, all the elements are connected as required by 35 U.S.C. 112, second paragraph. Accordingly, Applicants respectfully request that the rejection be withdrawn." In response to Applicants' argument, the fact that the host "can access e-mails on said server" is irrelevant. The claims are directed to an apparatus, and therefore, structural cooperative relationships between elements recited in the claims must be set forth according to MPEP 2172.01. MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second

paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements including the "means for mapping" function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. It is suggested that with support from the originally filed specification, the word "connected" may be used to provide structural relationships between elements. Applicants also argue that "[t]he Examiner also states that the phrase "sending an e-mail using physical address of a recipient" is unclear in claim 8. Applicants respectfully traverse. The Examiner is attempting to narrow the scope of Applicants' invention inappropriately based on his comments by reading limitations from the specification into the claims. This is inappropriate. See MPEP 2173.04 ("Breadth of a claim is not to be equated with indefiniteness.") Applicants' invention is sending a [sic] e-mail using the physical address of the recipient. This is clearly recited in the claim." The Examiner disagrees and maintains the rejection because the phrase "'sending an e-mail using physical address of a recipient" is unclear and misleading. It is common knowledge that one can only send emails using an email address, not physical address.

The Hogan 103 Rejection:

Applicants argue that "the Examiner has provided absolutely no motivation for Hogan to perform such a search within a billing system. The Examiner is

clearly using impermissible hindsight to reject the claims." In response to applicants' argument that there is no motivation to provide Hogan with a search capability, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, using a search engine to find email address is clearly old and well-known in the art. Applicants further argue that "[t]he Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a database is old and well known. The fact that searching a database is well known does not make it obvious to map a physical address to an e-mail address (for sending an e-mail message)." The Examiner disagrees. It is clear that searching a database using keywords includes searching any kind of database including email address database, for example. It is also clear that using keywords includes using any desired keywords including keywords specifying a physical address. As a matter of fact, using a search engine to find an email address using a physical address is notoriously old and well-known. The following is a screenshot showing a typical search engine mapping an email address to a physical address:



BEST AVAILABLE COPY

Applicants also request that the Examiner provide proof of these statements that predates the filing date of the above-captioned application.

- 1) "tagging an email as time sensitive is old and well-known"
- 2) "using biometric data for accessing an electronic mailbox [is old, well-known] and involves ordinary skill in the art.
- 3) "e-mail notification to a buyer after an on-line purchase is a common practice in e-commerce."

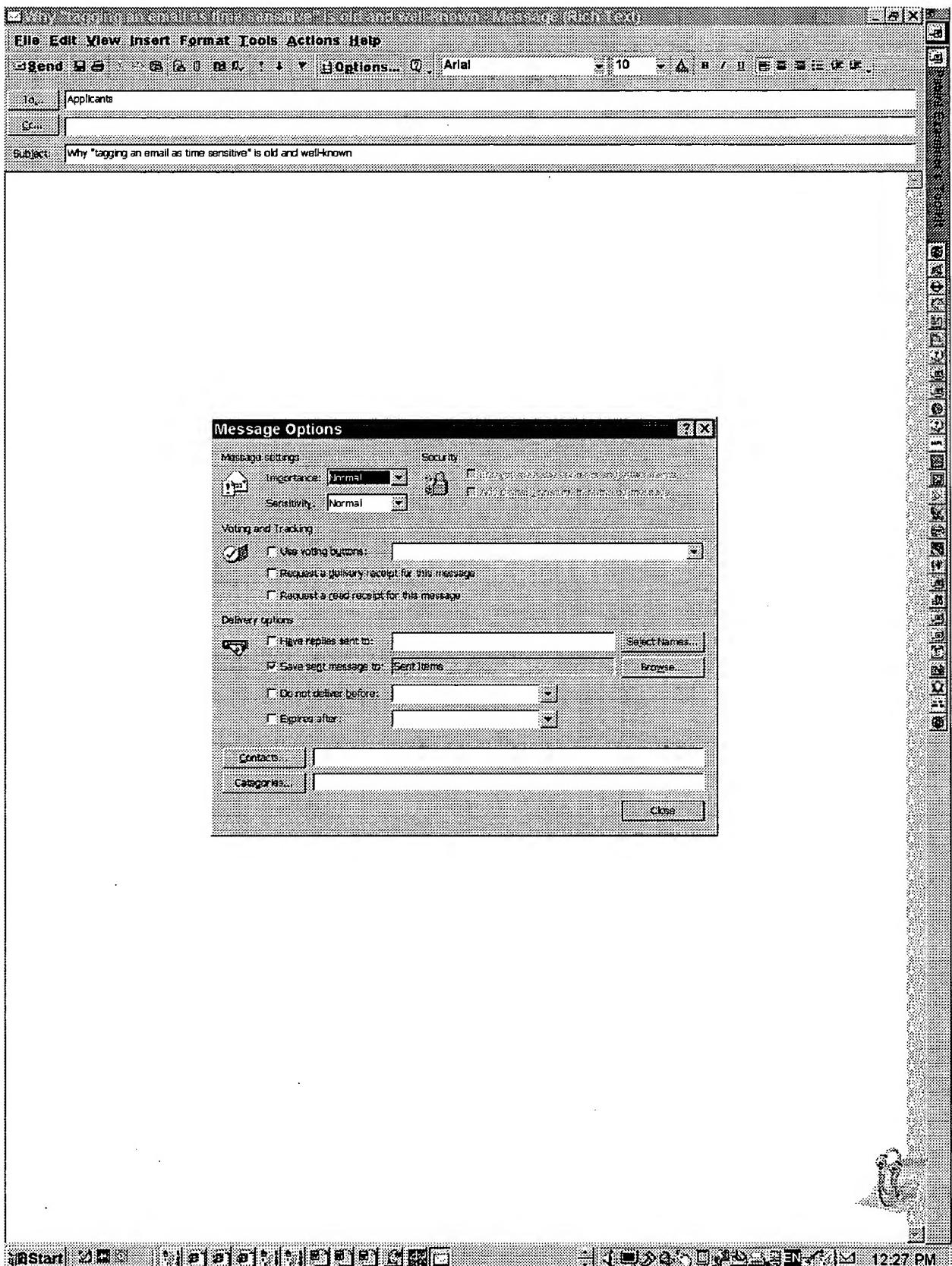
In response, Applicant's attention is first directed to MPEP 2144.03.

MPEP 2144.03 clearly states that "it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without (emphasis added) the support of documentary evidence provided the facts so noticed are of notorious character and serve only to 'fill in the gaps'." Further, MPEP 2144.03(c) also clearly states that in order to "adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ ... A general allegation that the claims

define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate."

Thus, in light of the MPEP 2144.03, it is clear that a mere allegation or a bald statement such as, "Applicants respectfully request that the Examiner provide proof of these statements that predates the filing date of the above-captioned application" is not adequate and does not shift the burden to the Examiner to provide evidence in support of the Official Notice. Allowing such a statement to challenge Official Notice would effectively destroy any incentive on the part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts. In the instant case, as noted above, Applicant has not provided any adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. However, in an effort to advance prosecution of this case, supportive documents/evidences are provided below nevertheless.

Creswell et al. (6,775,690) clearly states that "[f]requently, users send [email] messages in one form or another that are time sensitive. For instance, a reply to a message may be required by a certain date or the information in the message is no longer relevant." Another example is the commonly used Microsoft Outlook. The following is a screenshot showing "Message Options" in Microsoft Outlook. One can set the "importance" of an email by checking either Normal, High, or Low. It is clear that emails with High Importance level will require attention in a more timely fashion than those with Low Importance level. In another word, the emails sent using Microsoft Outlook can be tagged as time sensitive.



BEST AVAILABLE COPY

Baird, III et al. discloses an apparatus and method using biometric authentication process to allow users' access to a server. Note that the term "server" clearly includes an email server.

Sending an e-mail notification to a buyer after an on-line purchase is a common practice in e-commerce. For example, after an on-line purchase from Amazon.com, an email confirmation will be sent to the buyer's email account. Such a practice is so notoriously old and well-known, and therefore, as a matter of course, predates the filing date of the originally filed application.

The Zoken 103 Rejection:

Applicants argue that "Zoken, like Hogan, fails to teach or suggest mapping a physical address of a recipient to an e-mail address as admitted by the Examiner. There is simply no motivation within Zoken to make such a modification to the system of Zoken." The Examiner disagrees. Zoken discloses a method of storing an email in an electronic mailbox and mapping the email address of a recipient to a physical address of a recipient. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zoken to provide the option of mapping the physical address of a recipient to the email address of a recipient, since such modification is merely a design choice and involves only ordinary skill in the art. In response to applicant's argument that there is no motivation to modify the reference, the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of a physical address to find an email address is generally available in the art. See discussion above and the Infospace screenshot.

The Savino 103 Rejection:

Applicants argue that Savino does not disclose “using physical address of a recipient to be used to send an e-mail.” It is first noted that such a phrase is unclear and does not meet the requirement set forth in 35 USC 112, 2ND paragraph (see rejection and discussion above). As disclosed, an email is sent to a recipient using e-mail address after matching the recipient’s physical address with the recipient’s e-mail address. In any event, the rejection is based on a combination of Savino and general knowledge in the art. It is clear that it is old and well-known to use e-mail address after matching the recipient’s physical address with the recipient’s e-mail address. Further, sending an e-mail notification to a buyer after an on-line purchase is a common practice in e-commerce. For example, after an on-line purchase from Amazon.com or Dell.com, an email confirmation will be sent to the buyer’s email account. Such a practice is so notoriously old and well-known, and therefore, as a matter of course, predates the filing date of the originally filed application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang
Primary Examiner